

### **REMARKS/ARGUMENTS**

This Amendment and the following remarks are intended to fully respond to the Final Office Action dated January 12, 2004. In that Office Action, claims 1-49 were examined, and all claims were rejected. Reconsideration of these objections and rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

Claims 1-49 are in the application. Claims 1, 15-18, 19, and 33-36 have been amended. Claims 4, 13, 14, 22, 31, and 32 have been canceled. No new claims have been added. Therefore, claims 1-3, 5-12, 15-21, 23-30, and 33-49 remain present for examination.

The Application respectfully points out that amendments to claim 1 have been made only to include matter previously presented in canceled dependent claims 4, 13, and 14. Similarly, amendments to claim 19 have been made only to include matter previously presented in canceled dependent claims 22, 31, and 32. Additionally, amendments to claims 1 and 19 include limitations previously presented in independent claim 37. Amendments to claims 15-18 and 33-36 are only to correct dependency of these claims based on the cancellation of claims 4, 13, 14, 22, 31, and 32. As such, the Applicant believes that the amendments presented here do not present new matter, do not require an additional search, and place the claims in condition for allowance. Therefore, the Applicant requests that the amendments be entered.

### **Claim Rejections – 35 U.S.C. § 102**

Claims 1, 2, 4, 5, 12, 19, 20, 22, 23, and 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,529,942 of Gilbert (hereinafter “Gilbert”). The Applicant respectfully traverses the rejection and submits the following arguments pointing out significant differences between the pending claims and Gilbert.

Generally, the pending claims relate to sending a pre-selected portion of a document to a recipient via electronic mail. Sending the pre-selected portion of the document includes receiving a pre-selected portion of a document and receiving a command to send the pre-selected portion of the document to a recipient via electronic mail. In response to receiving the command to send the pre-selected portion of the document, the pre-selected portion of the document is coded for transmission via electronic mail. An electronic mail application program is launched and the coded pre-selected portion of the document is inserted into an e-mail message. In response to receiving a command to apply an interactive control to the pre-selected portion, an

interactive control is coded for the pre-selected portion. As described in the detailed description and consistent with common usage, an interactive control permits a recipient to perform functions with the pre-selected data such as filtering, sorting, and calculating, without having to launch and execute a separate application. (See pages 25-27) The coded interactive control is inserted into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. The coded pre-selected portion of the document and the interactive control is then sent to the recipient via electronic mail.

Gilbert relates to providing recipient specific formats in electronic mail. (Col. 1, lines 8-10) Under Gilbert, "an originating user of the electronic mail message causes the format commands to be embedded within the text, including an identifier code for identifying a specific recipient's electronic mail message. The embedded format commands are recognized for automatically generating a separate, properly formatted electronic mail message for each specific recipient." (Col. 1, lines 54-61) That is, Gilbert is directed to embedding text format commands in an e-mail message input by the user. However, these text format commands cannot be considered equivalent to interactive controls. They do not permit a recipient to perform functions with the pre-selected data such as filtering, sorting, and calculating, without having to launch and execute a separate application. They only provide formatting information to a program that is started to render the email message. They do not provide interaction.

Claims 1 and 19, upon which claims 2, 5, 12, 20, 23, and 30 depend, relate to sending a pre-selected portion of a document to a recipient via electronic mail and recite in part "detecting a command to apply an interactive control to the pre-selected portion of the document; in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion; and sending the coded pre-selected portion of the document and the interactive control to the recipient via electronic mail." Gilbert does not teach in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion.

Rather, Gilbert teaches embedding text format commands in an e-mail message, the text format commands providing formatting information to a program that is started to render the email message. For at least these reasons, claims 1, 2, 5, 12, 19, 20, 23, and 30 are not anticipated by Gilbert and should be allowed.

**Claim Rejections – 35 U.S.C. § 103**

Claims 6-8, 11, 13, 14, 16-18, 24-26, 29, 31, 32, 34-36, 37, 39-41, 44, 45, and 47-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilbert in view of U.S. Patent No. 6,157,934 of Khan et al. (hereinafter “Khan”). Claims 3, 9, 10, 21, 27, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilbert in view of U.S. Patent No. 5,748,188 of Hu et al. (hereinafter “Hu”). Claims 12 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilbert. Claims 15 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilbert in view of U.S. Patent No. 6,542,923 of Nguyen (hereinafter “Nguyen”). Claims 38, 42, and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilbert in view of Khan et al. as applied to claim 37, and further in view of Hu et al.

The Applicant respectfully traverses the rejections since the Examiner has failed to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, the Examiner must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j). As will be discussed in detail below, the references cited by the Examiner fail to teach or suggest each claimed limitation. Specifically, the references, alone or in combination, fail to teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. Further, the Examiner does not provide evidence that the suggestion or motivation to modify or combine the reference cited is explicit or implicit in the reference cited. Further, the Examiner does not provide any evidence that knowledge of one skilled in the

art would provide the suggestion or motivation to modify or combine the reference. Finally, the Examiner does not provide evidence of a reasonable expectation of success of such a modification or combination.

**Claims 6-8, 11, 13, 14, 16-18, 24-26, 29, 31, 32, 34-36, 37, 39-41, 44, 45, and 47-49**

Claims 6-8, 11, 13, 14, 16-18, 24-26, 29, 31, 32, 34-36, 37, 39-41, 44, 45, and 47-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilbert in view of Khan. As discussed above, Gilbert is directed to embedding text format commands in an e-mail message input by the user. However, these text format commands cannot be considered equivalent to interactive controls. They do not permit a recipient to perform functions with the pre-selected data such as filtering, sorting, and calculating, without having to launch and execute a separate application. They only provide formatting information to a program that is started to render the email message. Therefore, Gilbert does not teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. Rather, Gilbert teaches embedding text format commands in an e-mail message, the text format commands providing formatting information to a program that is started to render the email message.

Khan is related to a distributed client/server spreadsheet software for workflow automation. (Col. 1, lines 12-13) Under Khan, “server and client computers are configured to have a main spreadsheet on the server computer and client spreadsheets on the client computers, links from cells in the main spreadsheet to cells in the client spreadsheets, and directional instructions for sequentially routing data among client and main (server) spreadsheets.” (Col. 1, line 64 - col. 2, line 3) “The directional instructions may cause the server computer to perform only the calculations and other operations for the workflow which are best performed at a central location. The directional instructions may also cause the multiple, client spreadsheets at client computers to display and massage only the parts of the workflow data which are relevant to the user who participates in the workflow process at that client computer.” (Col. 2, lines 21-28) Khan does not teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and

inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. Rather, Khan teaches a spreadsheet program running on a server sharing data with a spreadsheet program running on a client.

Claims 1, 19, and 37, upon which claims 6-8, 11, 16-18, 24-26, 29, 34-36, 39-41, 44, 45, and 47-49 depend, relate to sending a pre-selected portion of a document to a recipient via electronic mail and recite in part “detecting a command to apply an interactive control to the pre-selected portion of the document; in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion; and sending the coded pre-selected portion of the document and the interactive control to the recipient via electronic mail.” Neither Gilbert nor Khan, alone or in combination, teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. Rather, Gilbert teaches embedding text format commands in an e-mail message, the text format commands provide formatting information to a program that is started to render the email message while Khan teaches a spreadsheet program running on a server sharing data with a spreadsheet program running on a client. For at least these reasons, claims 1, 6-8, 11, 16-18, 19, 24-26, 29, 34-37, 39-41, 44, 45, and 47-49 should be allowed.

#### **Claims 3, 9, 10, 21, 27, and 28**

Claims 3, 9, 10, 21, 27, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilbert in view of Hu. As discussed above, claim 1, upon which claims 3, 9, and 10 depend, and claim 19, upon which claims 21, 27, and 28 depend, are distinguishable from Gilbert since Gilbert does not teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-

selected portion. Rather, Gilbert teaches embedding text format commands in an e-mail message, the text format commands providing formatting information to a program that is started to render the email message.

Hu is related to a hypertext data processing system wherein graphical data is transmitted from a server computer to a client computer and displayed to a user. (Col. 1, lines 20-22) Under Hu, “the graphical information is sent using tag extensions of the HyperText Markup Language (HTML). A group of tags their corresponding attributes and graph data make up a graph element representative of the graph to be displayed. A server computer formulates the graph elements and sends them to a client computer via a network. The client computer parses the graph elements into the graph attributes and graph data and creates an object to pass to the graph server which resides in the client computer. The graph server displays the object representative of the graph.” (Col. 1, lines 52-63) That is, Hu teaches tag extensions to HTML to indicate formatting to a graph server running on a client system for rendering graph data. Therefore, Hu is similar to Gilbert since the tag extensions of Hu, as with the text format commands of Gilbert, are used only for rendering the data, not for providing interaction.

Claims 1 and 19, upon which claims 3, 9,10, 21, 27, and 28 depend, relate to sending a pre-selected portion of a document to a recipient via electronic mail and recite in part “detecting a command to apply an interactive control to the pre-selected portion of the document; in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion; and sending the coded pre-selected portion of the document and the interactive control to the recipient via electronic mail.” Neither Gilbert nor Hu, alone or in combination, teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. Rather, Gilbert teaches embedding text format commands in an e-mail message, the text format commands provide formatting information to a program that is started to render the email message while Hu teaches tag extensions to HTML to

indicate formatting to a graph server running on a client system for rendering graph data. For at least these reasons, claims 3, 9, 10, 21, 27, and 28 should be allowed.

#### **Claims 12 and 30**

Claims 12 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilbert. As discussed above, claim 1, upon which claim 12 depends, and claim 19, upon which claim 30 depends, are distinguishable from Gilbert since Gilbert does not teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. Rather, Gilbert teaches embedding text format commands in an e-mail message, the text format commands providing formatting information to a program that is started to render the email message. For at least these reasons, claims 12 and 30 should be allowed.

#### **Claims 15 and 33**

Claims 15 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilbert in view of Nguyen. As discussed above, claim 1, upon which claim 15 depends, and claim 19, upon which claim 33 depends, are distinguishable from Gilbert since Gilbert does not teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. Rather, Gilbert teaches embedding text format commands in an e-mail message, the text format commands provide formatting information to a program that is started to render the email message.

Nguyen is related to “a method and system for formatting electronic mail for transmission.” (Col. 1, lines 45-46) Under Nguyen, “electronic mail messages include the operational results of one or more applets. An electronic mail client creates an electronic mail message using one or more applets, each of which may operate to actively receive, transform,

and display information to be presented with the electronic mail message. At or near a time when the electronic mail message is formatted for transmission, editable program code for the applets is removed, and any dynamic links between the applets are broken.” (Col. 1, lines 46-56) That is, Nguyen teaches applets for formatting an email message. However, the electronic mail client sends only the transformed information generated by the applets rather than the entire applets. (Col. 3, lines 23-29) Therefore, the applets of Nguyen are similar to the text formatting commands of Gilbert in that they are used only for the formatting or rendering of the data, not for providing interaction.

Claims 1 and 19, upon which claims 15 and 33 depend, relate to sending a pre-selected portion of a document to a recipient via electronic mail and recite in part “detecting a command to apply an interactive control to the pre-selected portion of the document; in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion; and sending the coded pre-selected portion of the document and the interactive control to the recipient via electronic mail.” Neither Gilbert nor Nguyen, alone or in combination, teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. Rather, Gilbert teaches embedding text format commands in an e-mail message, the text format commands provide formatting information to a program that is started to render the email message while Nguyen teaches sending only the transformed information generated by the applets rather than the entire applets. For at least these reasons, claims 15 and 33 should be allowed.

#### **Claims 38, 42, and 43**

Claims 38, 42, and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilbert in view of Khan as applied to claim 37, and further in view of Hu. As discussed above, None of Gilbert, Khan or Hu, alone or in combination, teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control



for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. Rather, Gilbert teaches embedding text format commands in an e-mail message, the text format commands provide formatting information to a program that is started to render the email message. Khan teaches a spreadsheet program running on a server sharing data with a spreadsheet program running on a client. Finally, Hu teaches tag extensions to HTML to indicate formatting to a graph server running on a client system for rendering graph data.

Claim 37, upon which claims 38, 42, and 43 depend, relate to sending a pre-selected portion of a document to a recipient via electronic mail and recite in part “detecting a command to apply an interactive control to the pre-selected portion of the document; in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion; and sending the coded pre-selected portion of the document and the interactive control to the recipient via electronic mail.” None of Gilbert, Khan or Hu, alone or in combination, teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. For at least these reasons, claims 38, 42, and 43 should be allowed.

In summary, the combination of references relied upon by the Examiner are no more relevant to the claims than any of the references alone since the references, alone or in combination, fail to teach or suggest all claimed limitations. Specifically, the references fail to teach or suggest in response to receiving a command to apply an interactive control to the pre-selected portion, coding an interactive control for the pre-selected portion, and inserting the coded interactive control into the e-mail message with the coded pre-selected portion of the document so that the recipient can apply the interactive control to the pre-selected portion. The Examiner does not provide evidence that the suggestion or motivation to modify or combine the reference cited is explicit or implicit in the reference cited. Further, the Examiner does not

provide any evidence that knowledge of one skilled in the art would provide the suggestion or motivation to modify or combine the reference. Finally, the Examiner does not provide evidence of a reasonable expectation of success of such a modification or combination. As such, the Examiner has failed to establish a *prima facie* case of obviousness. The rejections should therefore be withdrawn and the claims be allowed.

**Conclusion**


It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance, and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

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